

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Satyan G. Pitroda

Group No.: 2618

Serial No.: 09/612,789

Confirmation No.: 9381

Filed: July 10, 2000

Examiner: Tan H. Trinh

For: System For Distribution And Use
Of Virtual Stored Value Cards

Attorney

Docket No.: 2683/79382

REQUEST FOR RECONSIDERATION

Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in Reply to the Official Communication mailed May 18, 2007 in the above referenced application. Applicant respectfully requests reconsideration.

REMARKS

Claims 1-19 stand rejected. No claims are added or canceled by amendment. Accordingly, claims 1-19 are at issue.

1. The Cited Portions of Stoutenberg Are Not Prior Art To The Present Invention.

When relying on earlier-filed applications to reject claims, the MPEP mandates that the subject matter used in the rejection **must be disclosed** in the earlier-filed application:

The subject matter used in the rejection **must be disclosed in the earlier-filed application** in compliance with 35 U.S.C. 112, first paragraph, in order for that subject matter to be entitled to the earlier filing date under 35 U.S.C. §102(e).

MPEP §706.02 (f)(1) (emphasis added). The present rejections to the claims are improper because they rely on subject matter that is not disclosed in earlier-filed applications that pre-date the filing of the present application.

The examiner states that Stoutenberg, U.S. Pub No. 200300222135 (filed on April 3, 2002) is being given the benefit of the filing date of Provisional Application No. 60/147,899 (filed on August 9, 1999). However, none of the written description that the Examiner cites from Stoutenberg actually appears in the Provisional Application No. 60/147,899. For example the Office communication mailed on May 18, 2007 cites to the following paragraphs of Stoutenberg: [0040], [0131-0132] (page 3 of Office communication); [0135], [0146-0148], [0147-0149], and [0150-0151] (page 5 of Office communication); [0146-0148] (pages 6, and 7 of Office communication). These paragraphs are not found in Provisional Application No. 60/147,899. Because the subject matter used in the rejections is not disclosed in the provisional application, the cited paragraphs of Stoutenberg are not entitled to the filing date of the earlier-filed application under 35 U.S.C. §102(e).

The Examiner contends that Provisional Application No. 60/147,899 “supported” Stoutenberg for the integrated point of sale POS, transaction using the credit, debit and Smart Card. See, Office Communication, p. 10. However, that is irrelevant because Stoutenberg is not relied on for such disclosures. Instead, on page 3, the Examiner cites Stoutenberg for disclosing virtual stored value such as a virtual card that comprises an image of a card. Applicant could find no mention of stored value cards or the issuance of virtual cards in Provisional Application No. 60/147,899. On page 5 of the Office Communication, the Examiner cites Stoutenberg for teaching a method of tracking retail sales of prepaid cards to cash subscribers. The paragraphs of Stoutenberg cited on page 5 of the Office communication concern a method of issuing and using phone cards. Applicant could not find the cited paragraphs or any method of tracking retail sales in Provisional Application No. 60/147,899. In short, the subject matter on which the rejections are based cannot be found in Provisional Application No. 60/147,899. The subject matter of the rejections is not entitled to the filing date of Provisional Application 60/147,899.

Stoutenberg lists in the Related U.S. Application Data that it is a continuation in part of application No. 09/634,901, filed on August 9, 2000, now U.S. Pat. No. 6,547,132. Stoutenberg is a mere continuation **in part** of the parent patent, and, like with the provisional application, the subject matter from Stoutenberg used in the rejection is not found in the parent patent, U.S. Pat. No. 6,547,132. Because cited subject matter is missing from the earlier-filed application, Stoutenberg is not entitled, under §102(e), to the August 9, 2000 filing date of the earlier-filed application.

In summary, the subject matter relied on for many of the present rejections is not entitled to a date under §102(e) earlier than April 3, 2002 because the earlier-filed documents do not disclose the cited subject matter.

2. Gaillard Is Not Prior Art To The Present Application.

Gaillard, U.S. Pub. No. 20030028458, is not prior art under §102(e) because the present invention precedes the earliest filing date in the chain of applications on which Gaillard claims priority. Also, under 35 U.S.C. §102(e), Gaillard is not entitled to the filing dates of earlier applications because it stems from an international application published in the French language, not the English language.

On October 31, 2005, Applicant submitted the Declaration of Satyan G. Pitroda, establishing a date of invention of at least June 20, 2000. This declaration is found under the “image file wrapper” tab when the application information is accessed through PAIR. Therefore, it is of record in the present application. The October 31, 2005 declaration establishes, through reference to a draft application prepared on or before June 20, 2000, that Applicant was in possession of the inventions as claimed in the present application before the earliest filing date (June 28, 2000) of Provisional Application No. 60/214,436, as referenced in Gaillard. Accordingly, Gaillard is not prior art for this reason. See, 35 U.S.C. §102(e) (requiring application to be “filed in the United States **before the invention** by the applicant for patent . . .”) (emphasis added). The present invention was made before the earliest filing date in the list of applications from which Gaillard claims priority, therefore Gaillard is not prior art under 35 U.S.C. §102(e).

Also, the reliance on the priority date (June 28, 2000) of Provisional Application No. 60/214,436, as the 102(e) date for Gaillard, U.S. Pub. No. 20030028458 (“Gaillard”) is in error. Gaillard should not be given the priority date of the earlier-filed provisional application for prior art purposes. First, Gaillard is a U.S. published application that claims the benefit of an international application WO 02/0152(A1), filed on March 21, 2001. To be entitled to an earlier filing date for prior art purposes, the international application (in this case, PCT application WO 02/0152(A1)) would have to meet all of the following *three* conditions:

- (a) an international filing date on or after November 29, 2000;

(b) designated the United States; and

(c) **published under PCT Article 21 (2) in English.**

MPEP §706.02(f)(1)(CC)(1) (emphasis added); See also, 35 U.S.C. §102(e) (“only if the international application . . . was published . . . in the English language”). The Gaillard PCT Application, however, was published in French, not English. Accordingly, the MPEP instructs that, for prior art purposes under 35 U.S.C. §102(e), Gaillard is not given an earlier priority date:

If the international application was filed on or after November 29, 2000, but did **not** designate the United States, or was *not published in English* under PCT Article 21(2), **do not treat the international filing date as a U.S. filing date >for prior art purposes<** . . . the reference may be applied under 35 U.S.C. §102(a) or (b) as of its publication date, or 35 U.S.C. §102(e) as of any later U.S. filing date of an application that properly claimed the benefit of the international application (if applicable).

MPEP 706.02(f)(1)(C)(2) (bold in original, italics added). See also, MPEP 706.02(f)(1) Examples 5, 8 and Flow Chart I. Gaillard is only entitled to the PCT publication date or a later U.S. filing date.

Additionally, even if Gaillard were able to claim the 102(e) date of its earliest priority application, because Gaillard is a continuation *in part* of several applications, the examiner has not shown that the earliest Provisional Application (60/214,436) discloses the subject matter used in the rejection. See MPEP 706.02(f)(1)(C)(1). Gaillard is not entitled to the date of its earliest provisional application for this additional reason.

3. The Rejections Relying On Stoutenberg and Gaillard Should Be Withdrawn.

Claims 1, 3-4, 8 and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over by Gaillard, U.S. Pub. No. 20030028458 in view of Stoutenberg, U.S. Pub No. 200300222135.

The rejections to claims 1, 3-4, 8 and 18 should be withdrawn because the published applications of Stoutenberg and Gaillard were filed after the filing date of the present invention, the subject matter of Stoutenberg relied upon in the rejections is not entitled to the filing dates of earlier applications, because Gaillard is not entitled to the filing dates of earlier applications, and because Gaillard's earliest possible date is after the date of invention of the present invention.

Claims 5-7 stand rejected under 35 U.S.C. §103 over Gaillard in view of Stoutenberg and further in view of Resnick (U.S. Pub. No. 20010001321). These rejections should be withdrawn for the reasons given above, i.e., the subject matter relied upon in Stoutenberg is not entitled to a filing date of any earlier application, and Gaillard is not properly asserted as prior art under 102 (e). Additionally, the rejection of claim 7 is impermissible hindsight re-creation of the invention because there is no support given for the examiner's *ipse dixit* assertion that the claim would have been obvious.

Claims 9-11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Stoutenberg in view of Johnson (U.S. Patent No. 6,535,726). These rejections should be withdrawn for the reasons given above, i.e., the subject matter relied upon in Stoutenberg is not entitled to a filing date of any earlier application. As an example, paragraphs 146-148, which comprise a portion of the subject matter relied upon for the rejection, refers to Fig. 5E. Fig. 5E is not found in the parent patent, nor is Fig. 5E found in Provisional Application No. 60/147,899, nor are paragraphs 146-148 found in the prior applications.

Claim 19 stands rejected under 35 U.S.C. §103(a) as being unpatentable over by Gaillard in view of Stoutenberg further in view of Hertzog (U.S. Pub. No. 20030069874). The reasons why Gaillard and Stoutenberg are not properly cited as prior art set forth above are incorporated herein by reference. The rejection should be withdrawn because neither reference is properly cited as prior art.

4. The Other Claims Are Also Patentable Over The Cited Documents.

Claims 12-16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Despres (U.S. Patent No. 6,434,379) in view of Pitroda (U.S. Patent No. 6,769,607). Despres teaches away from the present invention because it relies on physical media. See, e.g., Col. 4, ll. 52-56 (“In order to make the radio channel operate, the customer acquires two numbers, for example concealed on a prepaid card that he purchased in any sales outlet. These two concealed numbers are an authentication key and an account number.”); Col. 4, l. 66-Col. 5, l. 5 (“Before these steps, the operator will have to put ‘scratch cards’ on sale each containing an authentication code and an account number . . . The database knows all ‘scratch cards’ that are on sale.”). Despres does not render the present invention unpatentable because the management and sale of “scratch cards,” as required by Despres, is a **problem** to be **solved** by the present invention:

The mobile operator incurs some **cost for producing the plastic cards, packaging and distributing them**. In addition, the mobile operator incurs costs for **tracking and managing physical inventory**, ironically for a non-physical or virtual product such as airtime.

Retailers charge the mobile operators a very high margin for the distribution of these plastic cards, as they take up expensive shelf space. These margins form one of the integral components of the overall costs incurred by the mobile operator for the distribution of plastic pre-paid cards.

Application, p. 6 (emphasis added). The use of the term “virtual card” in Despres is different that what the term means in the present invention because the “virtual card” of Despres does not solve the problem of the distribution, tracking, and management of physical plastic cards. In contrast, claim 12 claims creating a virtual pre-paid card comprising a *digital* representation of information corresponding to information stored on a physical card, downloading the virtual pre-paid card to a retailer electronic transaction device, and transferring the virtual pre-paid card from the retailer electronic transaction device to a MO Subscriber Handset. Those steps are not disclosed or even

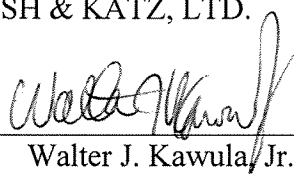
suggested in Despres, because that patent relied on the physical, not digital, distribution of cards to the handset subscribers. Additionally, Despres was cited in paper no. 7, mailed February 14, 2003, with respect to claims 9-11, and then apparently withdrawn as a basis for rejection. For the foregoing reasons, claims 12-16 are allowable over Despres.

Claims 17 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Despres in view of Pitroda further in view of Tushie (U.S. Patent No. 6,202,155). The remarks concerning Despres set forth above are incorporated herein by reference. Tushie does not disclose transferring a virtual prepaid card to a retailer electronic transaction device. In contrast, Tushie appears to disclose transferring information to equipment to manufacture a "physical transaction card." Tushie, Col. 2, ll. 51-54). Because Tushie does not disclose the additional element of claim 17, claim 17 is believed allowable.

Applicant respectfully submits that the claims are in condition for allowance, and such action is earnestly submitted. If the Examiner find that there are any outstanding issues which may be resolved by a telephone interview, the Examiner is invited to contact the undersigned at the below listed number.

Respectfully submitted,

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